



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/541,180	04/03/2000	James G. Burns	P-1183111	4983

7590 09/11/2002

SPYROS J. LAZARIS
OPPENHEIMER WOLFF & DONNELLY LLP
2029 CENTURY PARK EAST
SUITE 3800
LOS ANGELES, CA 90067

EXAMINER

HARRISON, JESSICA

ART UNIT PAPER NUMBER

3714

DATE MAILED: 09/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/541,180

Applicant(s)

Burns et al.

Examiner

J. Harrison

Art Unit

3714



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 14, 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 77-81 and 84 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 77-81 and 84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7 6) ☐ Other: _____

Art Unit: 3713

DETAILED ACTION


Continued Prosecution Application

The request filed on September 17, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/541,180 is acceptable and a CPA has been established. An action on the CPA follows.

Priority

This application is a Continuation of application serial No. 08/007742, filed 1/22/1993.

Information Disclosure Statement

Applicant's IDS of June 1st, 2002 has been reviewed. The documents crossed off 
Applicant's form 1449 do not constitute prior art to the instant application and have not been considered. The "Roulabette Booklet" has not been fully considered as it appears to be incomplete. Pages 15 - 18 and 20 - 25 are not contained with the submission. Applicant is requested to furnish these pages so that full consideration to the disclosure may be provided.

Art Unit: 3713

Terminal Disclaimer

The terminal disclaimer filed on June 1⁴, 2002 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent 6,048,269 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Specification

The amendments filed April 30, 2000 and June 1⁴, 2002 are objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The original disclosure fails to support the language added to the specification and claimed "means associated with a first of said plurality ...for printing a unique code representing an identification code" and "means for providing a first signal responsive to said unique code printed on said permanent storage record causing generation of a second signal representing an amount of credit for play associated with said unique code". This language was first presented in new claim 77 filed with the preliminary amendment of April 3, 2000 and has now been reflected into the specification under summary of the invention with the amendment of June 1⁴, 2002.

Art Unit: 3713

According to the originally filed disclosure, the bar code represents a unique identification. This identification includes the monetary value of the credit stored in the particular slot machine 200 *along with* a randomly generated number in order to permit the CPU 100 to verify the validity of the cash out slip at a later time (parent patent 6048269, col 6: 23-28). The combination of numbers is verified and checked for paid status before the credit is applied to a machine. The CPU 100 compares the bar code 222 on a particular slip with its memory which contains the value of the slip, the unique identification, and its status. This clearly indicates that two distinct numbers are bar coded on the slip, and that both are utilized in the verification step utilized for security. This is clearly a different arrangement from the now claimed/disclosed identification codes, and the use of a first signal responsive to said unique code printed on said permanent storage record causing generation of a second signal representing an amount of credit for play associated with said unique code. What is now disclosed and claimed indicates the credit value is somehow stored only in the CPU 100 and accessed through a printed out identification code, as this is the only structure possibly capable of being the "means" now claimed. There is no disclosure or reasonable support for the amended language where " a unique code represents an identification *code*, and means for providing a *first signal* responsive to said unique code ...*causing generation of a second signal* representing an amount of credit for play associated with said unique code".

Furthermore, applicant's deletion of the prior summary of the invention results in a disclosure that is not equivalent to the prior disclosure thus encompassing "new matter". In

Art Unit: 3713

particular, applicant has deleted the passage admitting that the "cash out slip is augmented by a unique control number randomly generated by the CPU in a well-known manner". The absence of this admission provides an invention not previously disclosed.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 77-81 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See discussion above with respect to new matter entered into the specification and pending claim 77.

Claims 77 - 81 and 84 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification, as amended, fails to provide any guidance as to the scope/meaning

Art Unit: 3713

of the "means for providing a first signal responsive to said unique code printed on said permanent storage record causing a generation of a second signal representing an amount of credit for play associated with said unique code printed on said permanent storage record". It can not be reasonable ascertained from a reading of the specification what structure comprises these means or how this unique code is generated so that it may be printed, read, and somehow used to generate signals as claimed.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Art Unit: 3713

Claims 77 is rejected under 35 U.S.C. 102(e) as being anticipated by Sarbin et al. (5,179,517), hereinafter Sarb. Sarb discloses a gaming system that pays credits responsive to an outcome of a game played (2:41) comprising: a plurality of gaming apparatus (2:42-43); and electronic memory storing an amount of credit (machine processor 62); means associated...for printing a unique code on a permanent storage record representing an identification code (read/write 42); a code reader ...capable of reading said unique code (read/write 42); and means for providing signals ...[authorize play of second apparatus](processor 46). Note that player card 20 includes the data fields as shown in Fig 5, including player id data 94 and value data 98. Also note teachings of 6:16 - 41 for teachings of "unique code" or player ID, and its use in the security aspects of the invention.

Claim 77 is rejected under 35 U.S.C. 102(b) as being anticipated by Chadwick et al GB 1558521 (hereinafter Chad). Chad discloses a gaming system that pays credits responsive to an outcome of a game played (1:18-21) comprising: a plurality of gaming apparatus (inherent, use of plural machines in disclosure); and electronic memory storing an amount of credit (machine processor 5 with RAM 10); means associated...for printing a unique code on a permanent storage record representing an identification code (read/write device 8); a code reader ...capable of reading said unique code (read/write 8); and means for providing signals ...[authorize play of second apparatus](processor 5). Note that player card includes the data which is encoded (binary

Art Unit: 3713

code) and includes identifying characteristics such as id data being recorded additionally for security purposes (3:75-85). The reference is deemed to meet the claim as broadly claimed.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 78-81 are are rejected under 35 U.S.C. 103(a) as being unpatentable over Chadwick et al. GB 1558521 (hereinafter Chad) in view of Patrick GB 1391060 (hereinafter Pat) and Sapitowicz et al US 4626672 (hereinafter Sap). The difference between the instant claims and Chad lie in the type of information carrier for the game credit data. Chad discloses magnetic encoding on a card, noting this is an advantage to the prior know Pat disclosure which utilizes optical mark-sense technology so that a printed receipt may be used to initiate play of a game. Chad's improvement over Pat includes the storage of the credit value, to be re-used by a player rather than the one time use disclosed in Pat. However, one of ordinary skill in the art at the time of the invention would have recognized the suggestion of Pat to use optical sensing technology and that the advantages of Chad could be implemented with an optical - sensing reader/writer arrangement. In particular, one of ordinary skill would look for a small, reliable optical

Art Unit: 3713

reader/writer mechanism which could be readily fitted into a gaming machine to substitute for Chad's read/write device. Sap provides such a mechanism, generally taught for use in an analogous gaming environment. Sap's device both reads and writes bar code, as well as writing text, on an inserted ticket. Further, Sap has the ability to write onto and dispense new tickets, which are stored in the device. His simple structure, versatility, and minimal maintenance requirements (12:29-39) make this device ideal for the gaming environment. It would have been obvious to one of ordinary skill in the art at the time of the invention to substitute Sap's optical sense read/write mechanism for Chad's magnetic read/write mechanism during implementation of the Chad teaching, in view of the suggestion in Pat to use optical sensing and tickets. Such would clearly work equivalently well and be more cost effective.

Claim 84 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sarbin or Chadwick as applied to claim 77 above, and further in view of Raven et al. US 5 429 361 (hereinafter Rav) and Gabrius et al. US 5 113 990 (hereinafter Gab).

Both Sarbin and Chadwick are related to game systems that operate without the use of coin input. They utilize encoded card technology to enter and retrieve credits from a game machine. Thus, they do not use coin or paper currency. Rav has been cited as illustrating a device which uses either coin or card, thus suggesting to one of ordinary skill in the art that both Sarbin or Chadwick would benefit from additional play if actuable by coin in addition to card. Further, Gab has been cited for his teaching of the use of paper currency in addition to coin, for added player convenience. Therefore, it would have been obvious to one of ordinary skill in the art at

Art Unit: 3713

the time of the invention to modify the machines of both Sarbin and Chadwick to accept monetary input in addition to encoded card input, and such monetary input would include both coin and currency as suggested by Rav and Gab, in order to increase usage and player convenience.


Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. All pertain to coded data input and/or output in gaming machines.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Harrison whose telephone number is (703) 308-2217.

jjh

September 3, 2002

A handwritten signature in black ink, appearing to be 'JH' followed by a long horizontal stroke.

JESSICA HARRISON
PRIMARY EXAMINER